

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Bijan TADAYON

Serial No. 10/777,044

Filed: February 13, 2004

For: Method and Apparatus for Dynamically
Assigning Usage Rights to Digital Works

Group Art Unit: 3621

Confirmation No.: 3920

Examiner: Jamie R. Kucab

Date: July 22, 2009

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellants submit the following response to the Notice of Non-Compliant Appeal Brief mailed June 22, 2009, in furtherance of the Amended Appeal Brief and Response to Notice of Non-Compliant Appeal Brief filed March 10, 2009, in response to the Notice of Non-Compliant Appeal Brief mailed February 25, 2009, in furtherance of the Appeal Brief filed on January 15, 2009, and in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed December 16, 2008.

The appeal proceedings in this case was instituted by the Notice of Appeal filed on October 28, 2008, in response to the Final Office Action mailed August 13, 2008.

Pursuant to MPEP 1205.03, an entire new brief is not submitted herein. Instead, Appellants submit the following amended “Summary of the Claimed Subject matter” section pursuant to 37 C.F.R. § 41.37(c)(1)(v), which provides the following:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

As stated above, 37 C.F.R. § 41.37(c)(1)(v) requires that “every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.”

SUMMARY OF CLAIMED SUBJECT MATTER

This Appeal is taken from the rejection of claims 1, 3-20, 22-37 and 39-54. Claims 1, 18, and 37 are independent claims. The present invention is generally directed to systems, methods, and computer program products for dynamically assigning usage rights to digital works.

Independent claim 1 relates to a method of dynamically assigning usage rights to digital content for use in a system having at least one repository. The method of dynamically assigning usage rights 218 includes specifying a usage right 218, determining a status of a dynamic condition 216, and dynamically assigning the usage right 218 to the digital content based on the status of the dynamic condition 216. See, for example, Figs. 2 and 3, and the discussions that follow in at least paragraphs [0010, 0021, 0023-0026, 0029, and 0030] of the present application. The usage right 218 includes computer readable data stored on a recording medium, and the data of the usage right 218 specifies an authorized use of digital content 203 that is

enforceable by a repository. [See, for example, Figs. 1-3, and the discussions that follow in at least paragraphs [0010, 0016, 0021, 0024, 0029, and 0030].

Independent claim 18 relates to a system for dynamically assigning usage rights to digital content, including at least one repository. The system includes means 200 for specifying a usage right 218, and the usage right 218 specifies an authorized use of digital content 203 that is enforceable by a repository. See, for example, Figs. 1-3, and the discussions that follow in at least paragraphs [0010 (“...specifying a usage right, the usage right specifying an authorized use of digital content and being enforceable by a repository...”), 0016 (“...the work is distributed as a document containing the content and associated usage rights...”), 0019 (“FIG. 2 illustrates a computer architecture for downloading digital works from distributor 120 to user 130 in accordance with the preferred embodiment...User 130 uses client computer 230...to communicate with computer server 200 associated with distribution 120.”), 00020 (“Server 200 is associated with distributor 120...), 0021 (“...rights module 214 which sets usage rights for content in accordance with the dynamic conditions monitored by dynamic conditions module 212...The usage rights can be assigned in any known manner....”), 0022-0023, 0024 (“The list of usage rights can include all rights that can be specified by the known XrML usage rights language or other grammars for digital rights management.”), 0025-0026, 0029 (“Usage rights can be any privileges or restrictions on use and/or distribution of the digital work or content thereof...the usage rights can be dynamically assigned or adjusted, constantly, periodically, or only when a digital work is to be distributed.”), and 0030 (“The distribution, accounting, and other functions of the distributor and clearinghouse can be accomplished by any party on any device...Usage rights and or accounting data can be encapsulated with the digital work or can be stored separately. Code for rendering, decrypting, or otherwise permitting or limiting use of the content can be stored on any device or can be encapsulated with the digital work. Any distribution arrangement can be used with the invention and such arrangements can include any combination of devices...communicating with one another in any manner as is necessary to transfer the desired

information.”)]. The system for dynamically assigning usage rights 218 to digital content 203 also includes means for determining 212 a status of a dynamic condition 216 and means for dynamically assigning 214 the usage right 218 to the digital content 203 based on the status of the dynamic condition 216. See, for example, Figs. 1-3, and the discussions that follow in at least paragraphs [0010, 0016, 0019-0026, 0029, and 0030] as described above.

Independent claim 37 relates to a device for enforcing usage rights assigned to digital content. The device includes means for receiving 230 the digital content 203 and means for requesting use 230 of the digital content 203. The device also includes means for enforcing use 200 of the digital content 203 in accordance with a usage right 218 specifying an authorized use of the digital content 218, where the usage right 218 is dynamically assigned to the digital content 203 based on a determined status of a dynamic condition 216. See, for example, Figs. 1-3, and the discussions that follow in at least paragraphs [0010, 0016, 0019-0026, 0029, and 0030] as described above.

The present invention permits existing usage rights to be assigned to content based upon a dynamic condition. However, the usage right need not be assigned to the content until the dynamic condition is satisfied. As an example, a usage right can specify that John may print a copy of the current issue of a daily newspaper. However, one might only want that right to be assigned to the content if John makes a purchase at a specific store. In this example, the invention permits the usage right to be dynamically assigned to a digital copy of the current day's newspaper upon detection of John making the purchase (through the store's point of sale computer system, for example). Prior to the purchase, the usage right was not assigned to the content. The dynamic assignment allows the rights to be assigned to the most recent newspaper at the time of purchase thereby permitting John to print that day's paper instead of a previous issue of the paper.

Pursuant to 37 C.F.R. § 41.37(c)(1)(v), Appellants have now clearly provided “a concise explanation of the subject matter defined in each of the independent claims involved

in the appeal.” In addition, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, has been identified and the structure, material, or acts described in the specification as corresponding to each claimed function has been set forth with reference to the specification. Based on a telephone conversation with Supervisory Examiner Andrew Fisher on July 21, 2009, Appellants believe the above revisions are clearly sufficient to fully satisfy the requirements of 37 C.F.R. § 41.37(c)(1)(v), and request that this appeal be immediately passed to the Board.

If the Examiner does not believe the portions of the specification referenced above are sufficient to support the claims as presented herein for any reason, Appellants respectfully submit that the Examiner should issue a new grounds for rejection under 35 U.S.C. § 112, and reopen prosecution, if necessary. Appellants do not believe a further Notice of Non-Compliant Appeal Brief based upon this issue would be proper. Of course, the Examiner is always invited to contact the undersigned attorney in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

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Date: July 22, 2009

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